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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,653	07/19/2006	Mario Polegato Moretti	293368US6PCT	7705

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LALLI, MELISSA LYNN

ART UNIT	PAPER NUMBER
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3728

NOTIFICATION DATE	DELIVERY MODE
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11/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/586,653	Applicant(s) POLEGATO MORETTI, MARIO	
	Examiner MELISSA L. LALLI	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 is/are rejected.
- 7) ☒ Claim(s) 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/19/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 14-19 and 24-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 14, 2009. It is further noted that although applicant indicated that claims 14-16 read on the elected species (C), fig. 4, the examiner disagrees in that claims 14-16 read on nonelected species (B), fig. 3 instead and has subsequently withdrawn claims 14-16. Even though certain structural aspects drawn to species (B) may be applied to the elected invention, these structural aspects are separate and distinct.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: page 8, line 5, "assembly 112" and page 8, line 28, "insole 216". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

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action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,769,201 to Pavelescu et al. (Pavelescu) in view of US 5,983,524 to Polegato.

Regarding claim 20, Pavelescu discloses a shoe (fig. 2) provided with sole and upper, comprising: a waterproof sole (10) and an assembly, which is associated with said sole in an upward region (fig. 2); an external upper (1), an internal lining (3), and a breathable and waterproof membrane (2; col. 1, line 66 - col. 2, line 3; col. 2, lines 31-36) located between said upper and lining (fig. 2); at least one insole (11), which is joined at least to said breathable and waterproof membrane (5); a waterproof insole (9; col. 4, lines 22-27), said insole being associated in a downward region with said insole (fig. 2), with a peripheral edge thereof completely overlapping a connecting region (fig. 2, at 5) between said insole and said breathable and waterproof membrane so as to provide a peripheral seal (fig. 2; col. 4, lines 12-27), said upper adhering to said insole (col. 4, lines 22-27), said waterproof sole being connected hermetically and peripherally with said assembly only at an exposed portion of said insole (col. 4, lines 29-33) and at said upper (figs. 2 & 3). It is noted that Pavelescu is silent regarding whether the

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outsole (10) is adhered to the upper (1) in the embodiment disclosed in fig. 2; however, Pavelescu does disclose the outsole (10) being adhered to the upper (1) in the embodiment of fig. 3 which is similar to the embodiment of fig. 2 (col. 4, lines 47-51). It would have been obvious to one having ordinary skill in the art at the time of the invention to have adhered the outsole to the upper in the shoe of Pavelescu in order to further prevent water from penetrating the shoe and to form a secure connection between the outsole and the upper assembly as taught by Pavelescu in the alternate embodiment of fig. 3 if the embodiment of fig. 2 is not already doing so.

Pavelescu is silent regarding whether the external upper and sole are each breathable and does not disclose the insole and waterproof inshoe each being partially perforated or breathable; however, Polegato discloses a similar shoe (fig. 7) having a breathable sole (313; col. 5, lines 1-11), a breathable external upper (311; col. 4, lines 60-64), a partially perforated or breathable insole (317; col. 5, lines 14-16), and a partially perforated or breathable inshoe (318; col. 5, lines 17-19) at a region of the sole that is assigned to vapor permeation (fig. 7). Additionally, Polegato discloses the connection between the sole and upper assembly being a perimetric band leaving free of connection a remaining central part that corresponds to the region assigned to vapor permeation to allow transpiration to occur through much of the surface of the foot sole and Polegato discloses the shoe being generally waterproof and breathable (col. 5, lines 29-34 and lines 47-64). It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the breathable elements of Polegato including perimetrically sealing the sole to the upper allowing an area of vapor

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permeation through the central part of the sole in the waterproof shoe of Pavelescu since it is desirable to make the shoe breathable as well as waterproof in order to ensure maximum comfort for the wearer of the shoe as taught by Polegato (col. 1, lines 30-34).

Allowable Subject Matter

5. Claims 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pavelescu et al. ('917) has been included because it is relevant to the claimed subject matter.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLL
11/09/09

/Mickey Yu/
Supervisory Patent Examiner, Art
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